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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/800,413	03/06/2001	John R. Hacker	758.924US01	2695

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EXAMINER

SAVAGE, MATTHEW O

ART UNIT	PAPER NUMBER
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1723

DATE MAILED: 03/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/800,413

Applicant(s)

HACKER ET AL

Examiner

Matthew O Savage

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 December 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-24 is/are pending in the application.
- 4a) Of the above claim(s) 22 and 23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19-21, and 24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 19, 20, and 24 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The limitation of the spin-on filter and bowl cartridge filter including a single piece housing as recited in amended claim 19 is considered new matter.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 19-21, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Austrian Patent 236,421 in view of Mules and Gullett '636.

With respect to claim 19, '421 discloses a filter head 1 having a center tube (e.g., defining port 3) defining an end, an outer tube (e.g., carrying seal 16), a first liquid flow port 2, a second liquid flow port 3, the outer tube circumscribing the center tube, the

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outer tube defining an end, an outer tube end port at the end at the end, an outer tube flow passageway extending between and in fluid communication with the first liquid flow port 2, the center tube defining a center tube flow passageway and a center tube end port, the center tube flow passageway extending between and in fluid communication with the second liquid flow port 3, the center tube projecting outwardly from the end of said outer tube, a bowl cartridge filter having a single piece housing 4 defining an interior and a cartridge filter 5 operably oriented within the housing interior, the cartridge filter including a region of filter media and a non-removable liner 9, the filter being in liquid flow communication with the outer tube end port and the center tube end port, a first seal arrangement 6 oriented to form a first seal to inhibit leakage between the outer tube flow passageway and the filter, and a second seal arrangement 15 oriented to form a second seal to inhibit leakage between the center tube flow passageway and the filter.

'421 discloses a bayonet connection between an outer region of the outer tube and the filter but fails to specify the filter as having a threaded region 16 threadably engaged to an outer tube threaded region of the filter head. Mules discloses that a bayonet connection and a threaded connection between the outer surface of an outer tube of a filter head and the inner surface of filter are known alternatives (see lines 38-45 of col. 4). It would have been obvious to have modified the '421 filter so as to have included the threaded connection as suggested by Mules in order to provide a known alternative connection for the filter. '421 and Mules fail to specify the limitation of the threaded connection having a cross sectional thickness no greater than 10 mm. Gullett discloses an analogous filter housing having a threaded region 22 having a cross sectional

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thickness no greater than 10 mm (see lines 12-17 of col. 4) and suggests that such a dimension provides the required strength for the threaded connection of an oil filter housing. It would have been obvious to have modified the combination suggested by '421 and Mules so as to have included a threaded region having a cross sectional thickness as suggested by Gullett in order to provide the required strength for the threaded connection of an oil filter housing.

Concerning claim 20, '421, Mules, and Gullett disclose bowl-cartridge filters with reusable housings and replaceable cartridges.

As to claim 21, Mules discloses the filter threaded region as being on an interior portion of the housing and the outer tube threaded region as being on an exterior portion of the outer tube (see lines 41-43 of col. 4).

Regarding claim 24, '421 discloses a cartridge filter including a cylinder of plated filter media (see line 4 of page 2) defining an open filter interior and the center tube 22 extending into the open interior.

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew O Savage whose telephone number is 703-308-3854. The examiner can normally be reached on Monday-Friday, 6:00am-2:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda W. Walker can be reached on 703-308-0457. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

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M. Savage
Matthew O Savage
Primary Examiner
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March 4, 2003